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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,013	08/21/2003	L. Pernille Olesen	POULaksel APP	1473

7590 09/20/2004
Poulsen Roser ApS
620 South Front Street
Central Point, OR 97502

EXAMINER

HWU, JUNE

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/647,013	OLESEN ET AL.	
	Examiner	Art Unit	
	June Hwu	1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/15/2004</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

The amendment filed April 15, 2004 has been acknowledged.

The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office action dated January 16, 2004.

Claim Rejections and Response to Arguments

Claim 1 remains rejected under 35 U.S. C. 112, first and second paragraphs, for the reasons stated in the last Office Action.

Applicants' amendment dated April 15, 2004 failed to address the following grounds of rejection:

- A. Page 2, lines 14-15, the recitation "pollen parent, 'POULdiram'" contradicts the description of 'Pouldiram' on page 2, lines 17-23 as the seed parent. Clarification and correction are necessary.

- B. Page 3, lines 11-15 describes the germination of seeds from the hybridization in the winter of 1995 and then describes the selection of the claimed plant in spring of 1995 on page 3, lines 16-18. The origin of the claimed plant is confusing. Clarification and correction are necessary.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the European Plant Breeder Right (PBR) application number 19990065 filed on January 29, 1999 and published on April 15, 1999, more than one year prior to filing of instant application, taken in view of Applicants admission that the claimed cultivar was first available for sale on July 16, 2001 (IDS filed on April 15, 2004). The application is a "printed publication" under 35 U.S.C. 102 because it is accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128.

Thus information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art. A publication relied upon as prior art under 35 USC 102(b) must be enabling. The text of the relied upon publication standing alone would not enable one skilled in the art to practice the claimed invention. However, when the claimed subject matter is disclosed identically by a reference, an additional reference may be relied on to show that the primary reference has an "enabled disclosure." *In re Samour*, 571 F.2d 559, 197 USPQ 1 (CCPA 1978) and *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985). See also MPEP § 2131.01. When the claim is drawn to a plant, the reference, combined with knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether 'Siokra' seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the 'Siokra' cultivar disclosed in the cited publications."). See also MPEP § 2121.03.

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The admission by the Applicants that the claimed cultivar was first sold on July 16, 2001, more than one year prior to the filing of this instant application is evidence that the claimed cultivar was in the public domain. The confirmation of sale anywhere in the world enables the cited publication because the disclosed cultivar could have been obtained and propagated from publicly available materials, and one skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation as shown by the Saxton reference. The breeder's name, address and phone number are disclosed in the Plant Breeder's Right document. As a result, one skilled in the art would know where to purchase the claimed plant.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the European PBR application number 20000291 filed on February 24, 2000 and published on April 4, 2000 and grant number 7939 dated July 16, 2001 and published October 15, 2001, more than one year prior to filing of instant application, taken in view of Applicants admission that the claimed cultivar was first available for sale on July 16, 2001 (IDS filed on April 15, 2004). The application is a "printed publication" under 35 U.S.C. 102 because it is accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221,226,210 USPQ 790,794 (CCPA 1981). See also MPEP § 2128.

As discussed above, the Applicants admit the availability of the claimed plant more than one year before the filing of this instant application. Public availability of the claimed plant would have enabled one skilled in the art to obtain and reproduce the plant disclosed in the European PBR document.

Response to Arguments

Applicants' arguments filed April 15, 2004 have been fully considered and the following arguments are not persuasive.

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Applicants argue that the 102(b) rejection does not apply to Plant Patent application. This argument has been carefully considered, however, is not persuasive because the same law applies to plant application as well as utility application. The law states, "The provisions of this title relating to **patents for inventions shall apply to patents for plants**, except as otherwise provided." See 35 U.S.C 161.

Applicants argue that "Foreign Commercial or Public use is Not a Bar to patentability under 35 U.S.C. 102(b)." This argument has been carefully considered, however, is not persuasive because it is not relevant. The clear wording of 35 USC § 102(b) is "A person shall be entitled to a patent unless - ... (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States ..." There is no restriction of the bar under 35 USC § 102(b) to printed publications in this country. The second clause of 35 USC § 102(b) barring public sale or use in this country is not relevant in this instant application because the basis of this rejection is the Plant Breeder's Right application published over one year prior to the date of domestic filing. Note that in Gandy v. Main Belting, there was no printed publication. The basis of that rejection was the public use in England. The Court reversed the judgment because the public use was not in the U.S. The issue in this instant application is the printed publication, and the knowledge of one of ordinary skill in the art where such a person could have obtained the publicly available plant stock, and reproduces the plant disclosed in the published document.

Applicants argue that the Patent Act of 1897 states that public sale must be in the United States and quote a passage stating "...patented or described in any printed publication in this or any foreign country..." This argument has been carefully considered, however, is not

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persuasive because the issue again as stated above is the foreign printed publication and not the “public use or sale.” The printed publication in “any foreign country” is a bar under 102(b).

Applicants argue that in the *LeGrice* case the court describes ‘Dusky Maiden’ and ‘Charming Maid’ had both received awards and were displayed in “catalogues”, more than one year prior to the U.S. filing date. This argument has been carefully considered, however, is not persuasive because the awards were not presented to the Court. There was no evidence of prior sale of these roses. Furthermore, the Examiner acknowledges that a foreign use or sale, undocumented by a patent or printed publication, is not a statutory bar under 35 U.S.C. 102. In *LeGrice*, Appellant never admitted that the rose cultivars were on sale. Indeed, the Court stated, “Prior public use or sale are the avenues by which a plant enters the public domain” (*LeGrice*, p. 372). The court then added, “section 102(b) requires that an inventor, who has placed his invention in the public domain, file his application within one year thereafter” (p. 372).

Applicants argue that the rose cultivars were listed in a “catalogue” and therefore were available for sale. This argument has been carefully considered, however, is not persuasive because the word “catalogue” is defined in the Webster’s Ninth New Collegiate Dictionary as “a complete enumeration of items arranged systematically with descriptive details or a pamphlet or book that contains such a list.” Therefore, the rose cultivars listed in the catalogue were not necessarily for sale. Moreover, there was no evidence on the record in *LeGrice* that the plants were on sale. Again this was not the issue considered by the Court.

Applicants then argue that the *Gandy v. Main Belting Co.* decision was the first to decide that foreign sale was not grounds for rejection under 102(b). This argument has been carefully considered, however, is not persuasive because in *Gandy*, there was no printed publication-just public use. In *Pentech International Inc. v. Hayduchok*, 18 USPQ2d 1337, it states that the “on-sale bar” must be “in public use or on sale in this country, more than one year prior to the date

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on the application for patent in the United States.” *Pentech v. Hayduchok* later states “a foreign use or sale, **without a printed publication** or patent as described in § 102(a), will not undermine the validity of a patent issued in the United States” (page 1343). For this instant application, the plant was described in the Plant Breeder’s Right applications and combined with the sale in a foreign country would therefore have enabled one skilled in the art to reproduce the claimed invention. As noted above the basis of this rejection is the second clause of 102(b). The printed publication and the public availability of the plant stock enable the disclosure.

Applicants argue that the Court in *Allied Colloids v. American Cyanamid Co.*, 35 USPQ2d 1840, 1995, decided that the commercial or public use of the claimed invention in a foreign country is not relevant in determining validity of a patent under 35 U.S.C. 102(b). This argument has been fully considered, however, is not persuasive because the district court states, “the April 16-17 tests an ‘experiment,’ but held that whether ‘there was some future or future improvements contemplated or necessary’ was ‘not relevant to the public use bar.’” (page 1845). In other words, the tests conducted in England were experiments and would not bar patentability because the product was never publicly available. That case is irrelevant because there was no printed publication. On the other hand, the rejection in this instant application is based on a printed publication and the availability of the claimed plant is cited as evidence of an enabling disclosure.

Applicants argue that the description in a printed publication must be enabling to the American public to bar patentability under 35 U.S.C. 102(b). This argument has been fully considered, however, is not persuasive because the clear wording of 35 USC § 102(b) is “A person shall be entitled to a patent unless - ... (b) the invention was patented or described in a printed publication **in this or a foreign country...**” (emphasis added). The publication is enabled because one of skill in the art could have made the instant plant by asexual

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reproduction of the publicly available plant as in this case. Applicants have made essentially the same argument repeatedly that the public policy behind all of title 35 and 35 USC § 102(b) in particular is to benefit the American public, and that, coupled with the explicit narrowing of the scope of 35 USC § 102(b)'s clause as to public sale or use to this country, necessarily implies that 35 USC § 102(b)'s second clause as to printed publication must similarly require that the invention be practiced in this country. 35 USC § 102(b) contains no such provision, nor is there any case that holds as such. Applicants' contention that *In re LeGrice* supported this because the court disregarded as immaterial evidence that the plant stock had been in public use or sale over one year prior to filing is unpersuasive because the issue was never before the court.

Applicants argue that *In re Paulsen* and *Advanced Display Systems Inc., v. Kent State University* require that every limitation of the claimed invention must be met. This argument has been carefully considered, however, is not persuasive because all of the limitations have been met. The claimed plant is specifically described in the PBR publication more than one year prior to the filing of this instant application. If the claimed plant were publicly available anywhere in the world, a person skilled in the art would have been able to purchase and reproduce the plant without further experimentation.

Applicants argue that the written description by itself is not enabling. The Examiner agrees with the Applicants that a publication by itself would not be an enabled publication, were the plant not in the domain. However, the PBR publications when considered in combination with the knowledge of one skilled in the art, i.e., the availability of the plant in the public domain as evidenced by the sale of the claimed plant more than one year prior to application for patent, places the plant in the public domain, and therefore is enabled since one skilled in the art would have been able to reproduce that exact same plant through asexual means. *LeGrice* ruled that a publication alone was not enough to put a plant in the public domain. The fact scenario of this

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rejection does not parallel the facts in the *LeGrice* case because the rejection here is not based on a publication alone. The PBR publications together with public availability of the plant, would have allowed a skilled artisan to take the teachings of the cited PBR and combine them with his own knowledge of the art to be in possession of the invention.

Applicants argue that the printed documents do not disclose any information on how to propagate the claimed variety. A skilled artisan would have knowledge as to how to propagate a rose plant. Saxton (1859) discloses several methods of propagating a rose (pages 45-60). In the specification of this instant application, Applicants describe the method of asexual propagation of the claimed plant by "traditional budding and rooted cuttings" (specification filed April 15, 2004, page 3, lines 19-22). Absent evidence to the contrary, a person skilled in the art would not have any difficulties reproducing the claimed plant. Hence, a printed publication combined with the knowledge of propagating a rose and possession of the claimed plant would be an enabling disclosure.

Applicants argue that a skilled artisan would not have been able to reproduce the plant in the United States before June 1999 because the claimed plant was under plant quarantine. This argument has been carefully considered, however, is not persuasive because the basis of rejection under 102(b) is the publication and it does not require that the plant be available in the United States.

On page 12, the recitation "Technology does currently exist which would allow a reader of a printed document to make a clone of a particular plant without access to the plant material itself, even in the simplest of plant species, let alone the *Rosa* species" contradicts the meaning the Applicants are trying to argue. This argument has been carefully considered, however, is not persuasive because it is believed that Applicants are arguing that with the current technology a printed document would not allow a person to make a clone of a plant without the

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plant itself. Examiner agrees with the Applicants that a person cannot reproduce the claimed plant with just a description alone, however, for the instant application the claimed plant was available to the public prior to the filing of this application. For the reasons stated above, the rejection is based on the printed PBR publications and Applicants' admission that the claimed plant was for sale on February 19, 2001. The sale of the instant plant puts it in possession of the public, which is the criterion, set forth in *LeGrice*.

Applicants argue that *LeGrice* and *Imazio* govern the application of 102(b) to plant patents, not *Ex parte Thomson*. This argument has been carefully considered, however, is not persuasive none of the analysis in any of those three cases distinguished 35 U.S.C. § 102(b) application to plant versus utility patents. The court in *LeGrice* stated "we therefore hold that descriptions in printed publications of new plant varieties, before they may be used as statutory bars under 35 U.S.C. 102(b), must meet the same standards which must be met before a description in a printed publication becomes a bar in non-plant patent cases." Therefore, none of *LeGrice*, *Imazio* or *Thomson* limited their application of 35 U.S.C. §102(b) to plant or utility patents. In *Imazio Nursery Inc. v. Dania Greenhouses*, the issue was infringement not 35 U.S.C. § 102(b). *Ex parte Thomson* does not overturn *LeGrice* as it supports *LeGrice*.

Applicants argue that a plant patent cannot be anticipated without the plant itself. Examiner agrees that a plant patent cannot be anticipated without the plant itself but public availability anywhere in the world enables the printed publication so that one of skill in the art could reproduce the available plant stock. The Applicants already admitted that the claimed plant was available to the public.

Applicants argue that there was no propagatable plant material in the United States, and therefore the printed publication would not be an enabling disclosure. This argument has been carefully considered, however, is not persuasive for reasons stated above; the basis for

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rejection under 102(b) is the printed publication. The public availability of the plant material anywhere in the world enables the cited publications.

Applicants argue that the Office should follow the decision made in *LeGrice*. Applicants argue the Court was concerned with whether or not the claimed rose plants were available to the American public and whether the knowledge that some day a printed publication would enable a person to reproduce a plant without the actual plant. The arguments have been carefully considered, however, is not persuasive because *LeGrice* never mentioned the word "American". The court simply said, "the public", which could be any where in the world. In *LeGrice*, Appellant never admitted that the rose cultivar was on sale anywhere. For reasons stated above the description of the claimed plant and the availability of the plant anywhere in the world would enable a person to reproduce the claimed plant. The Examiner agrees that a plant cannot be reproduced without propagatable plant material. In this case, propagatable plant material was in the public domain as admitted by the Applicants. Thus, the plant was readily reproducible.

Applicants argue the facts of the present case are materially distinguishable from the facts of *Ex parte Thomson*. This argument has been carefully considered, however, is not persuasive because the standards in utility and plant patents are the same. 35 USC 161 and 37 CFR 1.161 both state that patents for inventions shall apply to patents for plants, except as otherwise provided. Seeds in *Thomson* reproduce the claimed plant and cuttings in this instant application reproduced the claim plant. The issue is whether the plant can be reproduced. The manner of reproduction is insignificant. The ability to reproduce a plant that is in the public domain is the issue. As stated above, the printed publications are the basis of the 102(b) rejection. The availability of the claimed plant anywhere in the world enables the publication.

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Each and every limitation is taught in the publications as it is drawn to the same plant. Not each and every feature needs to be described, as they are inherent to the claimed invention.

Applicants argue that the claimed plant material was not accessible to the American public because it was under U.S. quarantine and the foreign owner never released the variety to the United States. As stated above, a foreign disclosure describing the claimed plant, published more than a year prior to the filing of the instant application, is an enabling bar under 35 U.S.C. § 102(b) where the plant stock necessary for propagation could have been obtained.

Because none of the arguments support Applicants' conclusion that a foreign breeder's right certificate over a year prior to domestic filing cannot be a bar under 35 USC § 102(b), even where Applicants made the plant stock available to the public, albeit outside this country, over a year prior to domestic filing, the applicability of a rejection, where both of these conditions arise, under 35 USC § 102(b) is maintained.

Conclusion

No claim is allowed.

Future Correspondence

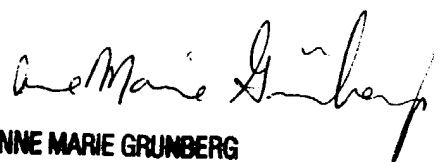
Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (571) 272-0977. The Examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JH


ANNE MARIE GRUNBERG
PRIMARY EXAMINER